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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,949	12/21/2001	J. Martin Carlson	T291.12-0013	2634

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EXAMINER	
LEWIS, KIM M	

ART UNIT	PAPER NUMBER
3743	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,949	CARLSON ET AL.	
	Examiner	Art Unit	
	Kim M. Lewis	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *29 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *23* is/are allowed.

6)☐ Claim(s) *13-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/05 has been entered.

2. Claims 13 and 17 have been amended as requested.

3. Claims 13-23 are pending in the instant application.

Allowable Subject Matter

4. Claim 23 is allowed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,943,623 ("Thompson") in view of U.S. Patent No. 5,188,124 ("Feret").

As regards claim 13, Thomson discloses a friction management method for a support object supporting a portion of a human body having support bones, tissue around the support bones and skin on an outer side of the tissue (constituted by the application of the skin plaster to the user in order to reduce friction, note col. 1,lines 20-30 and col. 1, line 65-col. 2, line 1), including selecting pressure regions of high loads when load is carried between the object and the human body supported (constituted by selecting the a corn on a toe, note col. 2, line 71-col. 3, line 8), applying one or more

selected individual patches(constituted by a plaster) interfaced between the object and the skin in the selected regions (note col. 2, lines 30-33), each selected individual patch having defined peripheral edges to encircle an entire individual patch (note the outer periphery of the plaster in Figs. 1-5) and being unattached to and independent of the support object or any other object adjacent the tissue until the patch is adhesively secured, the selected patches being made of material (polymerized tetrafluoroethylene/polytetrafluoroethylene) having an exposed surface of low friction within the peripheral edges (again note Figs. 1-5), and adhesively securing a patch in each selected area to the object or the tissue using an adhesive (note col. 1, lines 65-67, which discloses that adhesive 16 secures the plaster to the skin).

Thompson is silent as to the type of adhesive that is used on the plaster, thereby failing to teach a pressure sensitive adhesive (psa). However, Feret discloses an adhesive plaster constructed from a low friction material and a psa.

Absent a critical teaching and/or showing of unexpected results derived from the use of psa, the examiner contends that it would have been an obvious design choice to one having ordinary skill in the art to substitute the adhesive of Thompson for the psa of Feret since the applicant has not provided criticality of the psa in the claims or specification. Thus, the use of a psa fails to patentably distinguish applicant's invention over the prior art.

As regards claim 14, as can be read from col. 2, lines 30-33 of Thompson, the object can be a shoe. Further disclosed at col. 2, lines 70-73, the selected region includes the metatarsal-phalangeal joint (toe) region.

As regards claim 15, Thompson discloses at col. 2, line 72-col. 3, line 3, that the patches may be applied to any portion of the body where it is desirable to reduce friction.

As regards claim 16, Thompson fails to teach that the object is a prosthetic device having a socket for receiving a portion of a limb to be supported. However, Thompson does disclose, as previously recited, that that the patches may be applied to any portion of the body where it is desirable to reduce friction. As such, it would have been obvious to one having ordinary skill in the art to apply the patches between an interior surface of the socket and a supported limb.

As regards claim 17, Thompson substantially discloses all features of the claim including a method of reducing trauma to tissue supported on an object (constituted by the application of the skin plaster to the user in order to reduce friction, note col. 1,lines 20-30 and col. 1, line 65-col. 2, line 1) including steps of identifying a region where shear load on tissue is likely to cause damage (constituted by selecting the a corn on a toe, note col. 2, line 71-col. 3, line 8), and providing an individual low friction surface patch (constituted by a plaster constructed from polymerized tetrafluoroethylene/polytetrafluoroethylene) having a peripheral edge defining the patch between the region of shear load and the object (note the outer periphery of the plaster in Figs. 1-5) supporting the tissue by adhesively securing the patch to one of the tissue or the object using an adhesive, the patch being independent of the object or any other object adjacent the tissue until the patch is adhesively secured (note col. 1, lines 65-67, which disclose adhesive 16 that secures the plaster to the skin).

Thompson is silent as to the type of adhesive that is used on the plaster, thereby failing to teach a pressure sensitive adhesive (psa). However, Feret discloses an adhesive plaster constructed from a low friction material and a psa.

Absent a critical teaching and/or showing of unexpected results derived from the use of psa, the examiner contends that it would have been an obvious design choice to one having ordinary skill in the art to substitute the adhesive of Thompson for the psa of Feret since the applicant has not provided criticality of the psa in the claims or specification. Thus, the use of a psa fails to patentably distinguish applicant's invention over the prior art.

As regards claim 18, since the low friction material of Thompson is from polymerized tetrafluoroethylene/polytetrafluoroethylene, the coefficient of friction is substantially equal to that of from polytetrafluoroethylene.

As regards claim 19, the mental step of identifying support regions where low friction surface patches are omitted is inherently practiced when plasters are not placed on certain locations.

As regards claim 20, note Fig. 4, which discloses the plaster as having low coefficient of friction material exposed on oppositely facing support surfaces of the patch.

As regards claim 21, the modified device of Thompson fails to teach method of claim 17 including one of the steps of adding and relocating at least one low friction surface patch after the tissue has been loaded against on the object for a period of time. However, this step is not novel. It is common practice to adjust, add and readjust

support device after load has been placed on the device and the determination that additional support devices are necessary or replacement of the support device is necessary to provide necessary relief. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the application of the modified plaster of Thompson to include one of the steps of adding and relocating at least one low friction surface patch after the tissue has been loaded against on the object for a period of time in order to provide the necessary relief from high friction surfaces.

As regards claim 22, it is inherent that the modified plaster of Thompson is removable since nothing in Thompson nor Feret alludes to the plasters as being permanent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kim M. Lewis
Primary Examiner
Art Unit 3743

kml
August 4, 2005